

REMARKS

The Examiner rejected claims 2, 4, 5, 10, 17, 32, 40 and 41 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hatch *et al.* (USPN 4,929,370) in view of Weinreich (USPN 5,435,671).

The Examiner rejected claims 6-9, 12, 13 and 34-37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hatch *et al.* (USPN 4,929,370) in view of Weinreich (USPN 5,435,671) as applied to claims 2-5, 10, 17, 32, 40 and 41 above, and further in view of Frater (USPN 6,355,360).

The Examiner rejected claim 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hatch *et al.* (USPN 4,929,370) in view of Weinreich (USPN 5,435,671) as applied to claims 2-5, 10, 17, 32, 40 and 41 above, and further in view of Block (USPN 4,269,549).

The Examiner rejected claims 3 and 42 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hatch *et al.* (USPN 4,929,370) in view of Weinreich (USPN 5,435,671) as applied to claims 2-5, 10, 17, 32, 33, 40 and 41 above, and further in view of Sinclair *et al.* (USPN 5,824,582).

Applicants respectfully traverse the §103(a) rejections with the following arguments.

35 U.S.C. §103(a)Claims 2, 4, 5, 10, 17, 32, 40 and 41

The Examiner rejected claims 2, 4, 5, 10, 17, 32, 40 and 41 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hatch *et al.* (USPN 4,929,370) in view of Weinreich (USPN 5,435,671).

Applicants respectfully contend that claims 4 and 17 are not unpatentable over Hatch in view of Weinreich, because Hatch in view of Weinreich does not teach or suggest each and every feature of claims 4 and 17. For example, Hatch in view of Weinreich and further in view of Sinclair does not teach or suggest the features: "wherein the removable adhesive is a liquid while adhesively coupling the successive sheets to each other" (emphasis added) (claim 4); and "wherein the removable adhesive is a liquid while adhesively coupling said each sheet with its adjacent sheet" (emphasis added) (claim 17).

On pages 6-7 of the office action, the Examiner admits: "Hatch *et al.* and Weinreich ... fail to teach that the adhesive is a liquid while adhesively coupling the successive sheets to each other".

Accordingly, Applicants assert that the preceding admission by the Examiner demonstrates that the rejection of claims 4 and 17 as allegedly being unpatentable over Hatch in view of Weinreich is improper, because Hatch would have to be modified by a reference other than Weinreich to teach or suggest the preceding features of claims 4 and 17.

Although claims 4 and 17 were not rejected as allegedly unpatentable over Hatch in view

of Weinreich and further in view of Sinclair (USPN 5,834,582), the Examiner's citation of Sinclair in rejecting claims 3 and 42 will be addressed with respect to claims 4 and 17. In particular, the Examiner argues: "It is notoriously well known in the art that an adhesive material made with sucrose material is removable and may be applied as a liquid as evidenced Sinclair et al. (Col. 24, lines 15 - 20; Col. 55, lines 4 - 5). Therefore, absent demonstration of unexpected results, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have substituted the solid lubricant adhesive material in the modified Hatch et al. with a adhesive made from a sucrose material as taught by Sinclair et al. in order to have an strong bond between disparate materials (Col. 24, lines 34 - 36)."

In response, Applicants respectfully contend that Sinclair is not a suitable reference for modifying Hatch for at least the two following reasons.

A first reason why Sinclair is not a suitable reference for modifying Hatch is that Sinclair, col. 24 lines 15-20 states that "[t]he solvents to be used in the solvent-based adhesives can be a nonvolatile modifier part of the formulation". The preceding citation from Sinclair, which relates to Sinclair's "modifier" component of the adhesive, does not disclose that the adhesive material may be applied as a liquid. Applicant contends that it well known that a solvent may be solid solvent. Thus, the solvent in a solvent-based adhesive may be a solid solvent. See, e.g., USP 4,066,586 to Tanuma et al., issued January 3, 1978, Abstract ("The polyester-modified vinyl polymer is useful in a high-solid solvent type coating composition."). See also USP 4,843,117 to Chung, issued June 27, 1989, Title ("Dimethyl Sulfone As A Solid Solvent For Vinylidene Chloride Containing Polymers"). See also USP 6,387,994 to Chung, issued May 14, 2002, Title ("Combination of a Solid Solvent And A Melt-Processible Copolymer").

A second reason why Sinclair is not a suitable reference for modifying Hatch is that the Examiner's argument for modifying Hatch by the alleged teaching of Sinclair is not persuasive. Sinclair, col. 24 lines 34-36 discloses that the "polymers are especially suited to bonding together disparate materials". However, Sinclair's polymers serve as solute and not as solvent (see Sinclair, col. 24, lines 26-27). Applicants note that the Examiner's argument relies on Sinclair's modifier (e.g., sucrose), rather than Sinclair's polymer, as the basis for modifying Hatch, and Sinclair's modifier does not cause "bonding together disparate materials". Thus, the Examiner's stated reason for modifying Hatch by the alleged teaching of Sinclair is misdirected.

In addition, Hatch teaches away from: "wherein the removable adhesive is a **liquid** while adhesively coupling the successive sheets to each other", as explained next.

Applicants note that the Examiner alleges that Hatch teaches that the dry film lubricant described in Hatch, col. 5, lines 30-45 represents the removable adhesive of the adhesive layer that adhesively couples each pair of successive sheets of the stack to each other, as required by claims 4 and 17. However, the dry film lubricant described in Hatch, col. 5, lines 30-45 is "**dry**" and "is preferably any water soluble material having lubricating properties and which can be combined with a hardener capable of drying the lubricant to a **solid or semi-solid film-form**, resulting in a **dry lubricating film**" (emphasis added). Therefore, Hatch's dry film lubricant is most certainly not a liquid after being hardened by the hardener.

Moreover, Hatch teaches away from the dry lubricating film being in a liquid form with respect to the adhesive property. See Hatch, col. 3 lines 55-61 which recites: "the dry film lubricant comprises a water soluble lubricant hardened into a **solid or semi-solid film form**

sufficiently dry to adhere to a carrier sheet in a stable form and act as a lubricant for a high speed rotary drill passing through the sheet, without adversely affecting drill operation or the smoothness of the resulting drill hole" (emphasis added). In other words, Hatch teaches that the solid or semi-solid form of Hatch's disclosed dry film lubricant is a necessary condition for the dry film lubricant to have an adhesive functionality.

Also, the Examiner relies on the dry film lubricant embodiment described in Hatch, col. 5, lines 30-45, and this embodiment specifically includes a waxy hardener. Indeed, it is this waxy hardener component of Hatch's dry film lubricant that imparts the adhesive functionality to the dry film lubricant. However, the waxy component is "waxy" and is therefore solid and not liquid. Therefore, use of a liquid adhesive is incompatible with the dry film lubricant embodiment that the Examiner specifically relies on.

Also note that the word "dry" in "dry film lubricant" appears everywhere in Hatch: in the title, claims, abstract, summary of the invention, and detailed description. This pervasive appearance of "dry" in "dry film lubricant" throughout the Hatch disclosure makes it clear that Hatch intends that the dry film lubricant be "dry". Therefore, it is not obvious to modify Hatch to change the dry film lubricant to a liquid form while adhesively coupling the successive sheets to each other.

Based on the preceding arguments, Applicants respectfully maintain that claims 4 and 17 are not unpatentable over Hatch in view of Weinreich, and that claims 4 and 17 are in condition for allowance. Since claims 2, 5, 10 and 32 depend from claim 4, Applicants contend that claims 2, 5, 10 and 32 are likewise in condition for allowance. Since claims 40 and 41 depend from

claim 17, Applicants contend that claims 40 and 41 are likewise in condition for allowance.

Claims 6-9, 12, 13 and 34-37

The Examiner rejected claims 6-9, 12, 13 and 34-37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hatch *et al.* (USPN 4,929,370) in view of Weinreich (USPN 5,435,671) as applied to claims 2-5, 10, 17, 32, 40 and 41 above, and further in view of Frater (USPN 6,355,360).

Since claims 6-9, 12-13, and 34-37 depend from claim 4, which Applicants have argued *supra* to not be unpatentable over Hatch in view of Weinreich under 35 U.S.C. §103(a), Applicants maintain that claims 6-9, 12-13, and 34-37 are likewise not unpatentable over Hatch in view of Weinreich and further in view of Frater under 35 U.S.C. §103(a).

Claim 11

The Examiner rejected claim 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hatch *et al.* (USPN 4,929,370) in view of Weinreich (USPN 5,435,671) as applied to claims 2-5, 10, 17, 32 40 and 41 above, and further in view of Block (USPN 4,269,549).

Since claim 11 depends from claim 4, which Applicants have argued *supra* to not be unpatentable over Hatch in view of Weinreich and further in view of Sinclair under 35 U.S.C. §103(a), Applicants maintain that claim 11 is likewise not unpatentable over Hatch in view of Weinreich and further in view of Block under 35 U.S.C. §103(a).

Claims 3 and 42

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The Examiner rejected claims 3 and 42 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hatch *et al.* (USPN 4,929,370) in view of Weinreich (USPN 5,435,671) as applied to claims 2-5, 10, 17, 32, 33, 40 and 41 above, and further in view of Sinclair *et al.* (USPN 5,824,582).

Since claims 3 and 42 respectively depend from claims 4 and 17, which Applicants have argued *supra* to not be unpatentable over Hatch in view of Weinreich under 35 U.S.C. §103(a), Applicants maintain that claims 3 and 42 are likewise not unpatentable over Hatch in view of Weinreich and further in view of Sinclair under 35 U.S.C. §103(a).

In addition, Hatch in view of Weinreich and further in view of Sinclair does not teach or suggest the feature: "wherein the removable adhesive consists of a material selected from the group consisting of fructose, **sucrose**, water, and a water solution" (claim 3); and "wherein the removable adhesive, while adhesively coupling said each sheet with its adjacent sheet, consists of a material selected from the group consisting of fructose and **sucrose**" (claim 42) (emphasis added).

The Examiner relies on Sinclair for allegedly teaching use of sucrose in the removable, liquid adhesive composition recited in claims 3 and 42.

In response, Applicants note that Sinclair's adhesive comprises a combination of a polymer and a modifier (i.e., sucrose) (e.g., see Sinclair, col. 5, lines 24-27; col. 53, lines 21-22 and col. 54, line 1). However, claims 3 and 42 recite the closed-end language of "consists of ... sucrose" which excludes anything other than sucrose in the liquid adhesive. Thus, the liquid adhesive in claims 3 and 42 does not read on Sinclair which discloses sucrose in combination

with a polymer.

Based on the preceding arguments, Applicants respectfully maintain that claims 3 and 42 are not unpatentable over Hatch in view of Weinreich and further in view of Sinclair.

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CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457.

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